Paper No. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

<u>Ex parte</u> M. ANTHONY STONE, DARCY J. HARBAUGH,
and CLIFFORD V. MITCHELL

Appeal No. 2002-1033
Application No. 08/327,744

HEARD: JANUARY 14, 2003

Before COHEN, ABRAMS, and FRANKFORT, <u>Administrative Patent Judges</u>.

COHEN, <u>Administrative Patent Judge</u>.

<u>DECISION ON APPEAL</u>

This is an appeal from the final rejection of claims 1 through 8, all of the claims in the application.

Appellants' invention pertains to a method for removing honeycomb and braze from a substrate. A basic understanding of the invention can be derived from a reading of exemplary claim 1, a copy of which appears as EXHIBIT C attached to the main brief (Paper No. 30).

As evidence of obviousness, the examiner has applied the documents listed below:

Ackermann	4,218,066	Aug. 19, 1980
Ryan	4,409,054	Oct. 11, 1983
Shiembob	4,433,845	Feb. 28, 1984
McComas et al (McComas)	5,167,721	Dec. 1, 1992

The following rejections are before us for review.

Claims 1 through 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McComas in view of Shiembob, Ryan, or Ackermann.

Claims 1 through 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shiembob, Ryan, or Ackermann in view of McComas.

The full text of the examiner's rejections and response to the argument presented by appellants appears in the answer (Paper No. 32), while the complete statement of appellants' argument can be found in the main and reply briefs (Paper Nos. 30 and 35).

OPINION

In reaching our conclusion on the issues raised in this appeal, this panel of the Board has carefully considered appellants' specification and claims, the applied teachings,[1] the declaration of Clifford V. Mitchell (EXHIBIT E attached to main brief), and the respective viewpoints of appellants and the examiner. As a consequence of our review, we make the determination which follows.

We do not sustain the respective rejections of appellants' claims under 35 U.S.C. § 103(a), for the reasons addressed below.

Independent claim 1 is drawn to a method for removing honeycomb and braze from a substrate, said honeycomb having a base and a ribbon direction, comprising, inter alia, a liquid

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[1] In our evaluation of the applied prior art, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

stream striking the substrate at the base of the honeycomb, thereby removing the honeycomb and braze from the substrate.

At the outset, we note that the examiner has clearly expounded the basis for each rejection on appeal, and thoroughly addressed the arguments of appellants in the answer. However, for the reasons set forth, infra, the rejections cannot be sustained.

From our perspective, the combined teachings of the applied prior art, understood in light of the acknowledged background in the art (appellants' specification, page 1), would have been suggestive to one having ordinary skill of removing honeycomb and braze from a substrate by directing a liquid stream at the top of the honeycomb until the braze is exposed. The motivation for practicing the latter method would have been the teaching of McComas, in particular, in explicitly revealing liquid jet erosion as a viable alternative that does not result in substrate damage, the consequence of other known removal techniques. The deficiency, however, in the rejections before us is clearly seen to be the lack of any suggestion in the applied prior art teachings for the claimed recitation of a liquid stream "striking

the substrate at the base of the honeycomb." The examiner's attempt (answer, pages 21 through 24) to overcome the noted deficiency by reliance upon the skill in the art simply does not provide a sound evidentiary basis for concluding that appellants' claimed method would have been obvious. In other words, only appellants' disclosure, and not the applied prior art before us, teaches and would have been suggestive of a liquid stream striking a substrate at the base of honeycomb, as now claimed.

REMAND TO THE EXAMINER

We remand this application to the examiner to consider the patentability of the claimed subject matter under 35 U.S.C. § 103 based upon the acknowledged prior art (appellant's specification, page 1) or like patents in view of the McComas patent and, for example, a patent to Carr.[2] Carr (Fig. 2) appears to teach an alternative optimal path of media flow in the art (column 4, lines 55 through 66).

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[2] U.S. Patent No. 4,731,125, issued Mar. 15, 1988, and of record in the application.

In summary, this panel of the Board has not sustained the rejections on appeal. Further, we have remanded the application to the examiner to review the matter discussed above.

The decision of the examiner is reversed.

REVERSED AND REMANDED

IRWIN CHARLES COHEN)
Administrative Patent Judge)
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NEAL E. ABRAMS) BOARD OF PATENT
Administrative Patent Judge) APPEALS
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) INTERFERENCES
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CHARLES E. FRANKFORT)
Administrative Patent Judge)

ICC/lbg

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